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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,483	03/26/2004	Anthony William Whiley	DAVI202.001PUS	9152
20995	7590	07/22/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			HAAS, WENDY C	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/811,483	WHILEY ET AL.
	Examiner	Art Unit
	Wendy C. Haas	1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## • Status

1)  Responsive to communication(s) filed on 26 March 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 26 March 2004 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/21/2004.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 1 is rejected under 35 U.S.C. § 102(b)** as being anticipated by Australian (AU) plant breeder's rights (PBR) application 1998018, and grant number 1983, both made more than one year prior to the filing date of the instant application. Applicant provided copies of the published application and grant in the Information Disclosure Statement filed September 21, 2004. Both the application and grant indicate that the claimed plant was first sold in Australia in 1998. As such, the application and grant are enabled publications because they describe the claimed plant and because the claimed plant was publicly available, and thus reproducible. Use of this type of 102(b) rejection has been approved by the Court of Appeals for the Federal Circuit. *See, e.g., In re Elsner*, 72 USPQ2d 1038 (Fed. Cir. 2004).

**Claim 1 is rejected under 35 U.S.C. § 102(b)** as being anticipated by the QLD Country Hour Summary, published December 2, 2002 and in view of AU PBR 1983. The summary discloses the claimed plant variety and notes that 25,000 trays of fruit of the claimed variety were sold in the 2002 season. AU PBR 1983 is provided as extrinsic evidence that the characteristics of the claimed plant were known in the art and that the claimed plant was first sold in Australia in 1998. The QLD Country Hour Summary is an enabled printed publication

because it discloses the claimed plant, the characteristics of which were known in the art at the time the publication was made, and further discloses that the claimed plant was publicly available, and thus reproducible by one of ordinary skill in the art, more than one year prior to the date of the instant application for patent. Use of this type of 102(b) rejection has been approved by the Court of Appeals for the Federal Circuit. *See, e.g., In re Elsner*, 72 USPQ2d 1038 (Fed. Cir. 2004).

**Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by the Queensland Government announcement of Dr. Tony Whiley's retirement in view of AU PBR 1983.** The announcement, published February 15, 2002, discloses the claimed plant, 'B74', as "the latest mango taste sensation". AU PBR 1983 is provided as extrinsic evidence that the characteristics of the claimed plant were known in the art and that the claimed plant was publicly available more than one year prior to the instant application for patent. Use of this type of 102(b) rejection has been approved by the Court of Appeals for the Federal Circuit. *See, e.g., In re Elsner*, 72 USPQ2d 1038 (Fed. Cir. 2004).

***Objection to the Disclosure***

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the

plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. Applicants are requested to include the trade name, 'Calypso', of the claimed plant in the Specification.

B. Applicants' description of FIG. 1 refers to 'Kensington Pride' as illustrated on the left and 'R2E2' as illustrated on the right, however the photographs are arranged vertically. Applicants should amend this recitation to clearly indicate which variety is on top and which is on the bottom.

C. Applicants are requested to disclose whether the parent, rootstock and/or comparison cultivars 'Sensation', 'Kensington Pride', 'R2E2' and 'Keitt' have been patented in the United States, are currently the subject(s) of a pending U.S. plant patent application(s), or are unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, -(unpatented)-- should be inserted after the cultivar name, or such could simply be acknowledged in applicants' next response.

D. Page 2, line 23, applicants are requested to change "10-20" to - 10 to 20 - for sake of clarity.

E. Color is a distinctive feature of the claimed plant. Applicants should positively identify color designations for the features of the claimed plant with reference to a recognized color dictionary or color chart. The Royal Horticultural Society Colour Chart is recommended. The present recitation of redness of skin color using a Minolta Chroma Meter CR-200 is insufficient in this regard. See MPEP § 1605.

F. Page 3, lines 14 and 15, applicant recites: "The predominant skin color of ripe fruit of the new mango tree cultivar is red and yellow, while the predominant skin color of ripe fruit of 'Kensington Pride' is yellow and red." Red and yellow does not appear to be different or distinguishing from yellow and red. Further explanation or clarification of this supposedly distinguishing characteristic is needed. The same is true of the comparison of skin color between the claimed cultivar and 'R2E2' set forth on page 3, line 31 and page 4, lines 1 and 2 and the comparisons between the claimed plant, 'Kensington Pride' and 'R2E2' set forth in Table 1.

G. Applicants should provide the age of the tree as described.

H. Applicants should provide the cultural conditions the tree, as described, was grown under, including for example light levels, high and low ambient temperatures and rainfall in the location of culture.

I. Additional information should be imported into the specification relative to plant vigor so as to more meaningfully describe same. Such could include, (for example) amount of growth over a specified period of time.

J. Applicants should provide the height and spread of the tree described at a particular age and location of culture.

K. Page 5, line 8, applicants describe the fruit bearing of the claimed plant as "mid-late season". Applicants should provide the dates of first and full fruit ripening in the location of culture to positively quantify this recitation.

L. Page 5, line 9, Applicants state that the rootstock of the claimed plant is 'Kensington Pride', however, on page 2 applicants set forth that the tree, as described, was topworked to 'Keitt' trees that were originally grafted onto 'Kensington Pride'. Correction of this discrepancy is needed.

M. Applicants should describe the trunk of the claimed plant, providing the typical and observed diameter at a particular height from the ground in the location of culture. Applicants should also provide the trunk color with reference to a recognized color chart as well as the texture of the bark and whether or not lenticels are observed. If lenticels are observed, their size (length and diameter) as well as color and concentration (i.e. number per unit of area) should be set forth.

N. Applicants should more fully describe the branches of the claimed tree. Applicant should provide the diameter of the branches, their crotch angle at the point of attachment, color with reference to a recognized color chart, number of lenticels and a description of same and the surface texture of the branches.

O. Page 5, lines 13 and 14, applicants describe the anthocyanin coloration on young leaves of the claimed plant. Applicants should specify where the anthocyanin coloration is located and provide the color of same with reference to a recognized color chart.

P. Applicants should more fully describe the leaves of the claimed plant, providing the upper and lower leaf surface coloration with reference to a recognized color chart, the color and pattern of the leaf veins, and more information regarding the leaf margin shape (i.e. is it entire or serrated?)

Q. Applicants should also note whether or not the leaves have any stipules. If so, stipule length, diameter, shape, base shape, apex shape and margin shape as well as color with reference to a recognized color chart should be imported into the specification.

R. Applicants should more fully describe the petioles of the claimed plant. Applicants should provide petiole diameter and color with reference to a recognized color chart. Applicants should also specify whether or not the leaves or petioles of the claimed plant exhibit any glands. If so, glands should be described as to size, shape, color, number and location.

S. Page 6, applicants recite : "Percentage of bunch bearing inflorescences : approximately 66%." It is unclear what information this recitation is intended to impart. Specifically, what is a "bunch bearing" inflorescence? Clarification is needed.

T. Applicants should describe the inflorescences of the claimed plant more fully. Applicants should provide inflorescence type, size (length and diameter), panicle color (with reference to a recognized color chart) and texture and approximate number of inflorescences per tree, if known. Applicants should provide the typical and observed number of flowers per inflorescence.

U. Applicants should provide the dates of first and full bloom in the location of culture.

V. Applicants should describe the flowers of the claimed plant more fully. Applicants should provide flower size (length and diameter), flower color with reference to a recognized color chart for the upper and lower petal surfaces as well as the reproductive organs. Applicants should describe any sepals, as well as their size, diameter, color, texture and shape. Applicants should describe the size, shape and number of petals. Applicants should specify whether the flowers are predominantly male or perfect, or the ratio of male to perfect, if known.

W. Applicants should describe the reproductive organs of the claimed plant, giving, for example, stamen and pistil number, filament length and color, anther size, shape and color,

pollen color, amount produced and fertility, pistil shape, size and color and ovary number, size and color.

X. Applicants should specify whether the claimed plant is a regular or biennial bearer.

Y. Applicants should specify the fruit yield per plant or unit of area in order to positively quantify the productivity of the claimed plant.

Z. Applicants should provide the shipping and keeping quality of the fruit of the claimed plant, such as the number of days it keeps in a given set of storage conditions or its susceptibility to bruising in transport.

AA. Applicants should describe the fruit skin more fully. Applicants should provide the ground color of the fruit skin with reference to a recognized color chart. Applicants should also provide a color chart color for the red blush of the fruit skin and the approximate percentage of the surface that displays a blush. Applicants should describe the lenticels on the skin, if any. Finally, applicants should describe the thickness and tenacity of the skin.

BB. Applicants should describe the fruit flesh more fully. Applicants should provide a color chart color for the fruit flesh. Applicants should lend more substantive meaning to the recitation of "firm" flesh, such as providing a penetrometer reading for same. Applicants should provide the sweetness of the flesh, such as in % brix and the titratable acidity of same. Applicants should

describe the aroma of the fruit flesh. Applicants should specify whether or not the fruit exhibits a core, and describe same if present.

CC. Applicants should describe the seed more fully. Applicants should provide the seed length and diameter, the seed weight, the seed color with reference to a recognized color chart, whether or not the seed exhibits fibers and whether or not it is tenacious to the flesh.

DD. The following terms from TABLE 1 require clarification, as it is unclear to the Examiner what is intended by their use: "LSD/sig", "P<0.01", "ns" and "Percentage of bunch-bearing inflorescences" (again, what is a bunch-bearing inflorescence?) Clarification is needed.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

#### *References Cited*

The references cited but not made of record in any rejection herein are made of record to show the state of the art. The references cited in the rejections herein are believed to disclose the claimed plant.

***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 1661